

Appl. No. : 09/636,278  
Filed : August 10, 2000

## REMARKS

By way of the present amendment, Claims 43, 44, 49, 53-55, 58, and 63 are currently amended, while Claims 50 and 57 have been canceled. Claims 43-49, 51-56, and 58-64 remain pending for consideration in view of the following comments.

### **Claim rejections – 35 U.S.C. § 103**

Claims 44-48, 51, 54-56, 60, 61, 63, & 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,329,942 to Gunther et al. (“Gunther”) in view of U.S. Pat. No. 5,720,754 to Nelson et al. (“Nelson”). While item 4 of the Office Action does not specifically state that Claim 43 has been rejected under this basis, Applicant nevertheless presumes that Claim 43 was inadvertently omitted through typographical error because the narrower, dependent claims were rejected by the cited combination, and furthermore, the Office Action Summary states that Claim 43 stands rejected.

In addition, Claims 49, 50, 53, 58, 59 and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunther (‘942) and Nelson (‘338) in view of Mische et al. (5,490,859).

#### Claims 43-54

Applicant has amended Claim 43 to more fully define over Gunther. Gunther teaches a method and device for filtering blood. *See Abstract.* A filter is positioned at a location beyond the distal end of the catheter and the positioning assembly is locked to the catheter. *Id.* Subsequently, the filter captures particles as blood flows through it. *Id.* The cited combination of references does not add teachings to Gunther to make Claim 43 obvious. Specifically, Claim 43 recites, *inter alia*, “a resilient material encapsulating the expandable member.” None of the cited references, either alone or in combination, teaches or suggests the unique combination of features recited in Claim 43. Therefore, Applicant submits that Claim 43 defines subject matter patentable over the cited art. In addition, the claims that depend from Claim 43 each recite a unique combination of features not taught or suggested by the references, and are thus also each in condition for allowance.

#### Claims 55-64

During the Personal Interview Conducted on October 29, 2003, the Examiner indicated that Claim 55 should not have been rejected over Gunther and that the rejection of Claim 55 and its dependent claims will be withdrawn. Nevertheless, Applicant has amended Claim 55 to

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pursue alternative, more desirable embodiments. Claim 55 was not amended for reasons related to patentability, and the amendment is supported by the specification. *See Abstract*, which states “[i]f the expansion member is enclosed by a suitable membrane, the device seals with the vessel wall to partially or completely occlude the vessel.” Applicant submits that Claim 55 recites subject matter not taught or suggested by the prior art, either alone or in combination. Therefore, Applicant submits that Claim 55 is currently in condition for allowance and respectfully requests the same. In addition, the claims that depend from Claim 55 each recite a unique combination of features not taught or suggested by the cited references, either alone or in combination, and Applicant requests allowance of Claims 56-64.

#### **Claim Rejections – Double Patenting**

Claims 55-64 stand rejected under the judicially create doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-9 of U.S. Patent No. 6,312,407, which is the parent to the instant application. Applicant submits that the amendment to Claim 55 moots the double patenting rejection, and Applicant respectfully requests withdrawal of this rejection.

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### CONCLUSION

Claims 43, 44, 49, 53-55, 58, and 63 are currently amended, while Claims 50 and 57 have been canceled. Claims 43-49, 51-56, and 58-64 remain pending for consideration.

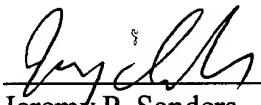
Applicant has endeavored to respond to each issue presented by the Examiner; however, if there remain any unresolved issues the Examiner is invited to initiate a telephone conference with Applicant's representative at the telephone number shown below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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